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Appl. Number: 09/978,215
Appl. Filed: 10/15/01
Applicant: Luis J. Rodriguez
Title: Self Sealing Letter Sheets
Examiner / GAU: Jes F. Pascua / 3727

2005 FEB -7 PM 2:59
BOARD OF PATENT APPEALS
AND INTERFERENCES

#45
Reg.
Rehearing

REQUEST FOR REHEARING**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

This is respectfully submitted under 37 CFR 1.197 (b) to request a Rehearing regarding the decision with mailing date of January 28, 2005, received on February 02, 2005.

The following are the specific grounds for this request:

1. It is apparent that the Board never considered Supplemental Brief submitted by Appellant on July 28, 2004. It is an established fact that it was not addressed. This is an extremely critical point of this request. Besides disputing arguments by Examiner, Appellant's Supplemental Reply Brief establishes a number of gross false statements by the Examiner.

Neither the Reply Brief or the Supplemental Reply Brief by Appellant are discussed in the prosecution history summarized on pages 2-5 of Decision of Jan. 28, concluding with the statement: "In this context, we therefore review the supplemental examiner's answer of Paper 40, mailed July 20, 2004.

2. As there are proven antecedents of tampering with the record by TC 3700 in this case, Appellant suspects that the reason that Reply Brief and Supplemental Reply Brief are not discussed could simply be the fact that just like Supplemental Brief before, they have "disappeared" before the Board could review them.

To make sure that these papers are in fact in the record, and that they are duly examined and considered, Appellant submits new copies of these documents. Likewise, copy of the Summary of Interview of Oct. 29, 2002 submitted by Applicant on 11/22/2002 is also enclosed.

Previous tampering and other actions by both Examiners in this case have been the object of complaints to the General Counsel Office and the Commissioner's Office.

To prevent any chance of any other sabotaging actions, a copy of this paper and its attachments is also sent to the Commissioner's and General Counsel's Offices.

Documentation about these issues is available at

<http://www.geocities.com/pto3700/978215>

Important Clarification

After reading the Decision on Appeal of Jan. 28, 2005, Appellant re-read the Decision on Petition of June 02, 2003, and Appellant now correctly understands that not all of the Attachments and Exhibits related to Amendment C are in the record.

It is clear now that any allusion to some of these attachments and exhibits by Appellant in Appeal Brief, Reply Brief, or Supplemental Reply Brief is moot. However, Amendment C itself is in full force regarding the Appealed claims.

Likewise, Exhibit A is in the record.

And the Summary of Interview by Applicant submitted on 11/22/02, is also in the record. Exhibit "F" was a new copy of it submitted with the Supplemental Appeal Brief, and it is not in the record.

The bottom line is that the Summary of Interview by Appellant is in the record, and it is a very important document of this case. This is very important in light of footnote (1) on page 7 of Decision on Appeal (Paper 44)

3. The undisputed Interview Summary by Appellant submitted on 11/22/02 and recorded as "Miscellaneous Letter" in the History Log of this case proves the Examiner's Summary was untruthful both by my assertion and by omission.

Examiner reports things that did not happen and failed to address relevant issues discussed during the interview. Among others, the **admitted** (37 C.F.R. 1.91(a)(3)) on the record EXHIBIT A. This exhibit moots any other argument by the Examiner.

See first paragraph of page 4, of Applicant's Summary of Interview, where the presentation of the entered model and its comparison with the cited art was discussed.

EXHIBIT A is in the Record, as per 37 CFR 1.191 (a)(3). Furthermore, EXHIBIT A was discussed during Interview of October 29, 2002, and as reported by Applicant's Summary of Interview of 11/22/02, (page 4, 1st paragraph) and it is therefore entitled to full consideration.

4. Silence about Reply Brief and Supplemental reply Brief is of alarming significance, especially in the circumstances of the present Appeal:

- a. The Appeal Brief was filed in Response to the final rejection by Examiner 1
- b. The Examiner Reply Brief was filed by Examiner 2.
- c. The Reply Brief abandoned all the reasons for rejection from Examiner 1, and Introduced new ones.
- d. Appellant's Reply Brief was submitted in Response to Examiner 2 Reply, and pointed this out.
- e. Board Remanded the case.
- f. Examiner 2 basically recycled his Reply Brief (This is proven in Appellant's Supplemental Brief) added some marginal issues, and stated that

«there is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection»

- g. This was utterly disputed in Reply Brief (Page 6, about middle of page). The only opportunity that Appellant has had to react to these rejections was after the Examiner's Reply Brief, i.e. after prosecution ended. And it is perplexingly obvious that not even then

his arguments to these new rejections have been considered given the absolute silence regarding Appellant's Reply Brief or Appellant's Supplemental Brief.

5. Decision of January 28, repeatedly refers to Appellant's position as being set forth on page such and such of the Appeal Brief, which is only partially correct. Decision of January 28 systematically ignores any rebuttals submitted with Reply Brief and Supplemental Brief. Why?
6. The Decision on Appeal appears to confuse Exhibit A with Affidavit 4 (Page 3, 3rd paragraph). Affidavit 4 was denied entry in the record. Exhibit A (model) was entered in the record, under 37 CFR 1.91 (a) (3) and it is due full consideration. Exhibit A was in fact presented during Interview of October 29, 2002, as reported in Applicants Summary of Interview. Summary of Interview is in the record as it was timely submitted on 11/22/02.
7. This has been clearly overlooked: A Patent Examiner in a particular field is to be considered of average skill in that field, and if the anticipation and obviousness issues alleged by another Examiner are in fact such, there should be total agreement between the two Examiners. However, the new Examiner opted to disregard all previous reasons for rejections, submitted during prosecution in favor of his own, submitted after prosecution was closed, (i.e. amounting to new rejections.)

Thus, the allegations of obviousness and anticipation by the original Examiner have been clearly and conclusively disproved by the second Examiner.

8. The following is to briefly address some particulars that have been overlooked and/or misapprehended:
 - i. There is clearly a confusion about the claimed invention evident in first paragraph of page 10 of Decision of Jan. 28.

The claimed Invention is illustrated with FIG. 7A, and no other figure.

And FIG 7A actually illustrates more than the claimed invention, because it shows some optional score lines, that only appear in dependent claims.

In addition to show how to produce the invention, the specification must also show how to use the invention. Hence, FIGS. 7B-7F.

Also, please refer to Pages 28-30 of Amendment C. ("What the Invention Is", and "How to Use The Invention"). These conclusive illustrated arguments also appear to have been overlooked.

- ii. Appellant has protested the new and *very creative* theory presented by the new Examiner to justify citing Schieman (or an envelope) against the appealed claims, which amounts to a new and hence forbidden rejection.

Paraphrasing, the new theory is that:

because an envelope is made of a single blank of a sheet of paper its body remains mono-sectional, regardless of how many panels, how many coatings of glue and how many overlaps of layers are involved in this body; and further disregarding the fact that such 'single' piece of a sheet material also produces the flaps, thereby reducing the body to just a fraction of such section. Hence the body would not be "mono-sectional" but rather "semi-sectional" or "partially-sectional" or whatever language best suits the case, but never 'mono-sectrional'.

- iii. Appellant has also protested the dishonest manner in which this new theory was presented:

"The Examiner maintains that the body of Schieman is mono-sectional to the degree that the body is formed from a unitary sheet of material."

Suggesting with the word 'maintains' that such theory was ever presented during prosecution. Prosecution is closed and this is a new rejection. Not to mention an absurd one, as exhaustively explained in reply Brief.

Please see Reply Brief, Page 15.

- iv. As for the alleged lack of clarity of the term "mono-sectional", Decision overlooks MPEP 2173.05 (e)

MPEP 2173.05 (e) «...There is no requirement that the words in the claim must match those used in the specification disclosure. Applicants are given a great deal of latitude in how they choose to define their invention so long as the terms and phrases used define the invention with a reasonable degree of clarity and precision.»

v. Or that the language must suit the Examiner's preferences. MPEP 2173.02.

The term mono-sectional can not be any more clear and specific in this or any other context. Any means of division is what would provide more than one section, and as there is not such a thing, (in the claims), there is simply and clearly only one section.

If the issue is that the drawings show score lines, then the issue may merit a drawing objection, not a claim rejection. The term fully complies with 112, as the combination of the prefix mono and the word sectional indicate in proper academic English: Having one Section. There is no "Special Meaning" involved nor Appellant is acting as his own lexicographer.

Furthermore, as the term was introduced in an effort to provide even further distinction over the cited reference(s), any possible lack of literal support in the specification, can easily be overcome with a minor amendment to such specification.

And further yet, as the original claims constitute part of the specification, and none of these claims recite score lines, the notion that the term 'body' needs to be interpreted using a particular embodiment is faulty. if ever recited, score line(s) appear in dependent claims. Please, see graphic discussion of claim 50 on page 59 of Amendment C. See Exhibit A.

Vi. Another important overlooked or misapprehended aspect is that even if hypothetically considering **(only hypothetically, because this an impossible notion)** the bodies of an envelope and the letter sheet of the present invention have comparable attributes, the structure of the 'flaps' alone is so different that these differences by themselves confer patentability to the claims.

Please refer to pages 41-52 in Amendment C. Schieman's first embodiment has a flap and a 'sub-flap' or a 'flap's flap'. Schieman's Second Embodiment has a 'flap to the body' and a 'flap to one of the walls of the body". How does that reconcile with the rejections?

Wilbur's first embodiment is identical to Schieman's second embodiment. Wilbur's second embodiment is similar the first embodiment, except that it has coatings on two sides of the sheet material. Again, How does that reconcile with the rejections?

vii. Decision of Jan. 28 overlooks a crucial and simple fact: A sheet of paper is a sheet of paper, and an envelope is a container. The envelope ceased to be a sheet of paper as soon as it became an envelope.

No individual artisan can be more representative of 'one skilled in the art' than the whole industry and the whole market segment of that industry. The definitions of the Industry and market of the field of the invention and the cited references (alleged prior art) have been clearly defined for the public (for generations) in the packaging of their products, as follows:

▶ The packaging of a Ream of paper says **500 SHEETS**.

▶ A Box of envelopes says: **ENVELOPES** - XYZ Count, Wherein XYZ indicates the number of pieces in the box.

Please, verify this statement. There is no need to get out of the Office (or Building) for this.

viii. Board also misapprehends the simple fact that an envelope is a container, just like a box, and that just like a box, which is also generated from one single sheet, an envelope can not preclude the instant invention due to their radical and categorical structural differences.

ix. Again, the Reply Brief and Supplemental Brief seem to have been completely overlooked.

This is another particular example:

The contention that Appellant's remarks regarding interaction of release and Pressure Sensitive Adhesive are "opinion" was disproved by Reply Brief (page 17). Reply Brief referred Examiner to Appeal Brief, pages 21(para. 5) through page 24.i. On page 12, Decision of January 28, 2005 claims that Appellant does not dispute the teachings of Johnson as discussed by the Examiner.

Not only has Appellant disputed all the arguments by both, the original Examiner and the new Examiner before and after prosecution closed, but Appellant has established that it is the Examiner who has failed to consolidate the teachings. What part of what reference goes with what part of the other reference and how. See page 17 of Reply Brief by Appellant.

Thus, replacing a dry adhesive for a Pressure Sensitive Adhesive as proposed, simply to justify

the use of another otherwise completely unnecessary release coating, can only be one of these two things: 1) Undue Hindsight 'anticipation' or 'prima facie', or more likely: 2) Invention. And this is only assuming that both of the two cited references are in fact analogous art, which they are not.

- x. On page 13 the Decision of Jan. 28 states the position of the Examiner in the Supplemental regarding some mode of producing the letters as if that was the issue presented by Appellant, and as if this was never before addressed by Appellant.

Appellant clearly indicated (paragraph between pages 18 and 19 of reply Brief) that the discussion of the production of the form and the problems associated with it, is not to evaluate the mode of production. The mode of production is irrelevant to product claims. This argument was presented as evidence that there is absolutely no reason, motivation or expectation of success in such combination. And this evidence remains uncontested.

AGAIN: All arguments and rebuttals to rejections by Appellant in Reply Brief and Supplemental reply Brief by Examiner remain unaddressed. Why?

It is clear that the Board knows of their Existence, as Reply Brief prompted the Remand which had urgent instructions to act immediately, given the Special status of this case, and at least page 9 (last para.) Of Decision of Jan. 28 mentions (Appellant's) Supplemental Brief.

For all the preceding, Appellant respectfully requests Rehearing of the Appeal and full consideration of all the overlooked items and issues specifically discussed herein and in Appellant's Reply Brief and Appellant's Supplemental Reply Brief.

Appellant was deprived of a fair Examination. Appellant certainly deserves a fair appeal.

Respectfully submitted,


Luis J. Rodriguez

-----Pro-Se Appellant-----

CERTIFICATE OF MAILING**Date of Mailing:** February 05, 2005

I hereby certify that this correspondence, including its attachments is being deposited with the United States Postal Service "EXPRESS MAIL TO ADDRESSEE" service # ED 560571471 US under 37 CFR 1.10 on the date indicated above, and is addressed to **Mail Stop Appeal Brief-Patents**, Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450

Luis J. Rodriguez,

Pro-Se Applicant

Signed:.....



In The United States Patent And Trademark Office

Appl. Number: 09/978,215
Appl. Filed: 10/15/01
Applicant: Luis J. Rodriguez
Title: Self Sealing Letter Sheets (*Formerly "Self Sealing Forms"*)
Examiner / GAU: Jes F. Pascua / 3727

REPLY BRIEF

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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BOARD OF PATENT APPEALS
AND INTERFERENCES

This is in response to Examiner's answer with mailing date of August 27, 2003.

I. Regarding Errors in Preliminary Items of Examiner's Answer

Item (2) **Related Appeals and Interferences**

Appellant clarifies that there was no statement identifying any related appeal or interference, as there are no related appeals and interferences.

Item (3) **Status of Claims**

The status of claims reported by Examiner is incorrect. See 37 CFR 1.192 (c)(3) The

status of claims in Appeal brief was correct.

While cancellation of Claim 60 was not entered, Appellant is not appealing claim 60. Therefore, claim 60 has no effect on this appeal.

Again, the correct status of claims is:

Claims 01-70 have been rejected.

Claims 01-44 have been cancelled.

Claims 45-70 are pending. *(This includes claim 60)*

Claims 45-59 and 61-70 are appealed. *(This excludes claim 60, as claim 60 is not appealed)*

Item (4) **Status of Amendments After Final**

Characterization by Examiner of the Status of amendments by appellant as incorrect is erroneous. Appellant reported that Amendment C had not been entered, and that a petition to the Director to reverse such ruling had been submitted and it was pending a decision. The statements by Appellant in the Appeal brief were correct.

Now that a decision has been rendered, it is more pertinent to state, as per paper 33 by the Director, regarding the After Final Action that:

- 1) All arguments and attachments submitted with paper 13 (entitled Amendment "C") related to original —**unamended**— claims 45-70 are entered. That is, except for the amended claims section (pages 3-20) and page 26, the entire paper 13 (Amendment "C") is entered in the record.
- 2) Amended claims 45, 49, 50, 53, 54, 57, 62, 67 and 68 are not entered.
- 3) Arguments submitted with paper 13 (entitled Amendment "C") related to amended claims 45, 49, 50, 53, 54, 57, 62, 67 and 68 are not entered.

The only arguments related to these claims are in page 26.

There is no Attachment or exhibit related to such claims.

On last paragraph of paper #33, the Director instructed Examiner to make sure that all amendments in Amendments A and B are properly and physically entered into the Application.

Director also instructed Examiner to consider all arguments in Amendment C which relate to claims and specification prior to the final rejection.

A chart summarizing items entered is submitted on next page..

SUMMARY OF ITEMS IN THE RECORD

AMENDMENT A

WHAT IS ENTERED

Everything

WHAT IS NOT ENTERED

AMENDMENT B

WHAT IS ENTERED

Everything, Except
Substitute Specification

WHAT IS NOT ENTERED

Substitute Specification

AMENDMENT C

WHAT IS ENTERED

Arguments, Attachments and Exhibits related to issues before final action, i.e.:

- Arguments on **pages 21-25**
- Arguments on **pages 27-76**
- Attachments **15-31**
- Exhibits **A-E**

WHAT IS NOT ENTERED

- Amendments to Specification
(pages 1 and 2)
- Amendments to Claims
(pages 3-20)
- Arguments about Amended Claims
(page 26)
- Affidavit 4

Item # (6) Issues

Examiner states: "The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:"

Then Examiner discusses some grounds of rejections of claims, which result incongruent and confusing, as Appellant did not present anything of that nature in the "**Issues**" section. It is noted that three officers subscribe the Examiner's answer.

Item # (7) Grouping of Claims

Examiner's grouping of claims is incorrect.

Po-se Appellant did not propose any grouping of claims different than the one established by default in O.A of 09/11/2003. The claims are grouped in just as many groups of two or more claims were rejected under the same grounds. Claims singularly rejected automatically stand or fall apart. Claim 60 is excluded of any consideration as claim 60 is not appealed.

Therefore, no statement by Appellant explaining the grouping is necessary.

Please, refer to 37 CFR 1.192

*Grouping of claims. For **each ground of rejection** which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.*

Thus, the grouping of the claims set forth in page 10, of Appeal Brief, was correct. As rejection of claims 45-53 under 25 USC 112 2nd para. was withdrawn, Appellant submits a revised chart reflecting the updated grouping on next page.

UPDATED Grouping of Claims

UPDATED to reflect Withdrawal of 35 112 rejection of claims 45-53 in Examiner's answer.

| GROUPED CLAIMS | GROUND OF REJECTION | LOCATION IN SEPT. 11/02 O.A. |
|--------------------------------------------------|--------------------------------------------------------------------------------------------------------------------------------------|------------------------------------------|
| i) 45-49 | 35 U.S.C. 112. first paragraph for alleged lack of disclosure of a 'mono-sectional' body | Page 2, Section 4. Page 3, Section 5. |
| ii) 49 | 35 U.S.C. 112. first paragraph because 'mono-sectional' is allegedly new matter | Page 3, Section 5, second sentence. |
| iii) 68-70 | 35 U.S.C. 112. first paragraph for alleged lack of disclosure of a letter sheet having a repositionable adhesive, and a dry adhesive | Page 3, Section 7 |
| iv) 45-47, 62-64 and 66 | 35 U.S.C. 102(b) as allegedly anticipated by Schieman | Page 5, Section 15 |
| v) 45-47, 49-51, 53-55, 57, 58, 62-64, 66 and 67 | 35 U.S.C. 103(a) as allegedly unpatentable over Johnson in view of Wilbur or Schieman | Pages 5/6, Section 17 |
| vi) 48, 52, 56, and 65 | 35 U.S.C. 103(a) as allegedly unpatentable over Johnson in view of Wilbur or Schieman and Stenner | Page 6, Section 18 |
| vii) 59 and 61 | 35 U.S.C. 103(a) as allegedly unpatentable over Johnson in view of Wilbur or Schieman | Pages 6/7, Section 19 |

Item # (8) **Claims Appealed**

Examiner incorrectly modifies the status of appealed claims as it is Appellant's prerogative to determine which claims are appealed. Appellant, therefore respectfully restates that the appealed claims are 45-49 and 61-70. Claim 60 is not appealed.

Copying the text of claim 60 was unnecessary, as although cancellation of the claim was not entered, it is not appealed either.

See 37 CFR 1.192, (c):

*(9) **Appendix.** An appendix containing a copy of the claims involved in the appeal.*

Claim 60 is not involved in the appeal.

Item # (9) **Prior Art of Record**

Examiner lists Schieman 2,367,440, Wilbur 2,384,223, Johnson 3,027,067, and Stenner 5,607,100, as prior art, which Appellant disputes, as this is considered incorrect.

Only Johnson relates to a letter sheet, which is not self sealing, and it is different in structural terms, and therefore its extent as prior art is debatable.

Item # (10) **Grounds of Rejection**

The grounds of rejection of appealed claims indicated by Examiner are incorrect, because:

- 1) Claims 61-67 are not rejected under 35 USC 112, first para.
- 2) Claim 60 is not being appealed.

For a summary view of the Grounds of Rejection, please, refer to the "**UPDATED Grouping of Claims**" on page 6 of this Reply Brief, which shows the grouping of the claims just as they stand rejected.

II. New Issues

Examiner's answer with mailing date of August 27/2003, raises a number of new issues which clearly have an effect on this case, as follows:

- 1) A new Examiner, Mr. Jes F. Pascua has been assigned to this case.
- 2) All the arguments submitted by the new Examiner are new, either because they address an issue never before responded to, or because they are different than arguments by original examiner.
- 3) These two factors compound the documented history of unfair actions, events and circumstances in this case.
- 4) The new Examiner characterizes Appellant's references to Amendment C as "numerous". Examiner also characterizes petitions by Applicant as "numerous". (Examiner's answer, last page, third para.) These characterizations have an editorializing effect on the record, as they suggest that these references and petitions may be unwarranted. This suggestion needs to be addressed by Appellant, as follows:

- a) Amendment C, and all its attachments responded to all the issues in O.A. of Sept. 11/02, which were without any exception proven incorrect. Furthermore, Amendment C included proactive efforts to disprove the persistent contention by Examiner that the present invention is an envelope.

If the references to Amendment C are "numerous", it is only proof of the overwhelming uncontested evidence supporting the invalidity of the rejections, which progressively grew throughout the prosecution phase.

Original Examiner never addressed any of these "numerous" arguments. Not

even after he specifically requested that Applicant indicated the differences of invention with respect to References. (See O.A. of June 20/02, page 11, 2nd para.) The 'numerous' character of the arguments was never questioned during examination.

b) If there are "numerous" petition issues, it is simply due to the fact that first, there were "numerous" errors and contradicting actions by the Director's Office, as proven by the Office's reversal of its previous rulings, as follows:

- 1) Paper 21 dismisses petition to waive suspension of rules related to timeliness, under 37 CFR 1.183 alleging that no fee was submitted.
- 2) Paper 23 (*sua sponte*) vacated the decision of paper 21, to correct the error as the fee had been paid, and to re-rule.
- 3) Paper 15 granted entry of model
- 4) Paper 24 denied 'entry' of the already entered model **[SIC]**
- 5) Paper 27 again **[SIC]** denied entry of the already entered model.
- 6) Paper 31 reversed ruling of Papers 24 and 27
- 7) Paper 29 denied entry of already entered **[SIC]** Amendment B, fails to respond to some petitions while it addresses issues that were not petitioned. **[SIC]**
- 8) Paper 33 overruled paper 29, correcting its errors, granting some of the petitions, and dismissing others on timeliness technicalities.

And second, it was necessary to resubmit some petitions regarding supervisory authority, because in spite of an understanding reached by phone with the Director, and other factors reported in paper # 34 by Applicant, none of the petitions was ever considered on its merits. None of

the serious complaints, which include proven, undisputed misrepresentation on the record by original Examiner were ever considered, as per Petition of May 12/03, page 2, last two paragraphs; page 10, third paragraph (Item 12)) and as documented by Exhibit F.

The Director's Office opted to dismiss the petitions on timeliness technicalities, disregarding its full power and authority to waive them to impart justice.

Paper 25 by director, announced that Examiner Garbe was promoted to a 'Quality Review' board, in high contrast with the petitions that such paper dismissed on technicalities, in spite of the seriousness of the complaints presented. Appellant respectfully submits that such sequence of events, at least raises a question about the equity of the Director's office, as it would be—at best—very ironical to overrule on improper actions amounting to poor quality of examination an Examiner who had just been promoted to a 'Quality Review Board'.

- 4) The statement by Examiner that all claims 45-70 fall together is incorrect. This is of alarming gravity, and is further aggravated by the fact that Examiner perfectly well knows that claims 45-70 were alternatively rejected under different grounds, as reflected by Examiner's #(10) item "Grounds of Rejection". After such statement, with such devastating potential, pro-se Appellant respectfully brings to the Board's attention that whether or not Examiner's answer is in good faith becomes an issue.

The grouping of claims by Appellant was correct. Since rejections of claims 45-53 under 35 USC 112, second paragraph, was withdrawn by Examiner's Answer, a new chart reflecting the current grouping of claims is submitted on page 6 of this Reply Brief.

- 5) The Examiner's answer is partial and selective of the arguments it addresses. Most

of the arguments by Appellant remain undisputed. Notably, not one of the visual exhibits and attachments was addressed by Examiner. Particularly notable all of the arguments, and exhibits disproving the Original's Examiner's contention that Applicant focused on explaining "**What The Invention Is Not**" instead of "**What the Invention Is**" remain undisputed.

Equally significant, all the allegations by original Examiner that this invention is an envelope, that it has panels, etc., which drove this case to this lengthy prosecution including an RCE and this Appeal, were abruptly and completely abandoned. In fact, the new arguments on last para. of page 7 of Examiner's answer's amount to a concession that envelopes are not analogous to this invention.

This concession automatically establishes patentability over alleged prior art, as the rejections under 102(b) and 103(a) were based and argued on this erroneous premise. In O.A of Sept. 11/03 Examiner referred to the invention as an 'envelope' in three separate instances.

- 6) Last page, third para. of Examiner's answer indicates that the decision on petition regarding Amendment C is summarized in paper # 33. Consistent with paper 33, Appellant respectfully submits a summary of rulings regarding Amendment C in the form of a chart on page 4 of this Reply Brief.
- 7) A review of the History of the case obtained on Sep.03/03 via fax from the Office reveals that more than five and a half months elapsed between the time the Appeal Brief was filed, and the time it was forwarded to the Examiner.

III. Reply to 'Response to Argument'

(Examiner's Answer, page 5, 5th para.)

Examiner argues that the remark "that claim 45 and its dependent claims 46-49 fully

complies with 35 USC 112" is 'opinion'; as if that is all that Appellant submitted.

That opinion is substantiated as a fact in the subsequent paragraphs, which Examiner opted to ignore.

See Appeal brief, page 11, (about middle of page), beginning with: "*See claims 1-22*"...

(Examiner's Answer, page 5, last para.)

Allegation that Appellant fails to address the rejection regarding "at least one" as a modifier of "mono-sectional" body is incorrect.

Appellant fully addressed this issue, both in "Amendment C", and in the Appeal brief. Please, refer to Appeal Brief, page 11, last line, and 5 first paragraphs of page 12.

Bottom-line:

Appellant disclosed "one" and "two" body embodiments, which validates the expression "at least one".

Among others, please refer to FIGS. 7A-7F which illustrate a letter sheet with one body.

Then, see FIGS, 24A-24N and 25A-25O, which respectively disclose two-way-self-sealing-mailers, having each two bodies (mailers).

(Examiner's Answer, page 6, 1st para.)

Allegation that Appellant fails to address the rejection regarding "at least one" in claim 49 is actually confusing, as such rejection (*first para. of page 3 of last O.A.*), encompassed claims 46-49, which is fully addressed along rejection of claim 45 in page 11 continued on page 12 of Appeal Brief. This had also been addressed in Amendment C.

The only rejection of claim 49 alone relates to the phrase "at least one mono-sectional flap", which is fully addressed by Appeal Brief on pages 12 (bottom half) and page 13 (2 first paragraphs)

(Examiner's Answer, page 6, 2nd para.)

The allegation that Appellant is silent with respect to the rejection of claim 60 is moot, as claim 60 is not appealed.

(Examiner's Answer, page 6, 3rd para.)

Regarding rejection of claims 68-70 under 35 USC 112, first paragraph, new Examiner now resorts to the following statement: "Neither appellant's original specification nor arguments explicitly state the "repositionable adhesive" to mean "low tack adhesive"

Prosecution of this case has been closed. It appears that Examiner is trying to present a "new" new matter rejection, as this contention was never before presented.

In any event, the allegation is incorrect, and such incorrectness will be addressed later, as it appears more significant to first address the fact that this is simply a trivial and frivolous argument. This is not 'opinion'. It is the law:

MPEP 2173.05 (e) «...There is no requirement that the words in the claim must match those used in the specification disclosure. Applicants are given a great deal of latitude in how they choose to define their invention so long as the terms and phrases used define the invention with a reasonable degree of clarity and precision.»

It is just a matter of simple logic that the only way an adhesive can be repositionable is if it is Pressure Sensitive, and if it is of low tack properties.

As already stated, Examiner's statement is incorrect. Although it is not necessary that claims have a **literal** antecedent in the specification or that such literal antecedent be indicated in the arguments, this was in fact established, as follows:

See paragraphs 1-4 of page 53 of paper entitled "Amendment C"

See Appeal Brief, page 4, 6th paragraph; in the "ISSUES" section, which examiner concurred with in his answer.

But, none of these considerations is even necessary, as Original Examiner admitted on

the record that the repositionable adhesive 204 had been disclosed. See Summary of Interview by Applicant, **(Exhibit F)** page 3, para. 6-8.

(Examiner's Answer, page 6, 5th para.)

Examiner indicates that Appellant is silent regarding claim 60 being indefinite.

Again, as claim 60 is not appealed, there is no point in discussing it.

(Examiner's Answer, page 6, 6th para.)

The argument by the New Examiner that "the self sealing letter sheet" or "the self sealing form" occur in the preamble is also new, in contrast with arguments by Original Examiner alleging that Appellant had focused on "what the Invention is not" instead of "what the invention is", and that the invention was an envelope, etc., (See O.A. of 09/11/2002, page 7, 2nd para.) and his request that Appellant pointed out the differences of the claimed invention with respect to the references (O.A. of June 20/02, page 11, 2nd para.), which prompted Attachments 11-14 and 15-31.

In any event, the new contention by new Examiner does not have any precluding effect. The new Examiner contends that "a preamble is generally not accorded any patentable weight, where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. (Then, a case is cited)

The above reasoning actually proves how improper the rejection is, since:

- 1) This is not a "general" abstract situation, but rather a very specific case.
- 2) **No** claim in this application recites any 'purpose' or 'intended use' in the preamble. (If at all, any 'purpose' or 'intended use' is recited, it is recited as a 'whereby' appendix at

the end of the claim.)

- 3) What the term "Self Sealing Letter Sheet" or "Self Sealing Form" in the preamble does is to specifically recite what the invention IS, in clearly assertive terms, fully supported by the specification, imparting vitality and meaning to the body of the claim. Without it, the body of the claim does not have any meaning. Without it, no invention is defined.

Please, see: MPEP 2111.02:

Weight of Preamble

"[A] claim preamble has the import that the claim as a whole suggests for it." Bell Communications Research, Inc. v. Vitalink Communications Corp., 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim."

(Examiner's Answer, page 7, 2nd para.)

The new Examiner states: "The Examiner maintains that the body of Schieman is mono-sectional to the degree that the body is formed from a unitary sheet of material."

First, this statement is grossly incorrect and improper, as the term "maintains" entails a previous claim of such notion, which never occurred. Examiner never claimed that Schieman's body is mono-sectional *'because it is formed from a unitary sheet of material.'*

This appears to be an attempt by the new Examiner to now be his own lexicographer, which is a role reserved for applicants only, and worse yet, it is so doing after the fact.

And even worse yet, such notion is in radical conflict with the meaning of the elements in this case, and it is further in conflict with just plain logic.

This is further confusing, as such "unitary sheet of material" also provides the flap(s). So, in this retrospective definition by the new Examiner, the flap(s) is part of the body, and as a result, nothing actually gets 'defined' by the definition.

Moreover, by embracing this definition, new Examiner contradicts the original Examiner, who disputed the mono-sectional character of the invention's body, allegedly 'because it

has panels'. See page 2, 5th and 4th lines from the bottom of O.A. of Sept. 11/2002.

Also, see O.A. of June 20 page 2, Section 3, particularly, the allusion "It appears that the two recited 'sections' are present regardless of whether the body is folded or not."

(Examiner's Answer, page 7, 3rd para.)

After absolute silence during Examination, Examiner refers to the features (Plural) that Appellant submits as the differences between current invention and the references, however only the "each flap" issue is addressed.

Examiner claims that what appellant submits as argument, is not recited in the rejected claims; i.e., that "each flap needs to be in contact with the body, and remain in a temporarily fastened condition until sealing is desired" is not in the claim. That is incorrect. The argument is an interpretation of the claim, so the essence of the argument is in fact recited in the claim:

Claim 45) ... **d)** *at least one layer of adhesive, and at least one layer of adhesive inhibitor applied to said blank of a sheet material, in such a manner that when said at least one mono-sectional flap is in contact with said at least one mono-sectional body, said at least one layer of adhesive faces said at least one layer of adhesive inhibitor, whereby said at least one mono-sectional flap and said at least one mono-sectional body can be removably fastened to one another,*

It is perfectly clear that the meaning of the argument, i.e., that each flap needs to be in contact with the body, and remain in a temporarily fastened condition until sealing is desired, is recited in other words by the claim.

It appears that Examiner is suggesting that claims should be worded as arguments. That is simply impossible, as there is no way Appellant could anticipate grounds of rejections, to argue them in advance in the claims.

All the other differences submitted remain undisputed.

Also regarding the 102(b) rejections, their validity is categorically disproved by the Examiner's admission that Schieman or Wilbur are not analogous art with a letter sheet

(See page 7, 4th para. of Examiner's Answer), as a 102(b) rejection must be based on a reference, anticipating the claimed invention, by showing all its structural features.

(Examiner's Answer, page 7, 4th para.)

After absolute silence during prosecution, on page 7, last paragraph, of the answer, new Examiner discusses Appellant's argument that Schieman and Wilbur are non-analogous art with respect to Johnson. Then, new Examiner offers some reasoning to this newly submitted argument and cites a case.

First and foremost, this constitutes admission by the new Examiner that they are non-analogous.

The allegation that Schieman and Wilbur are reasonably pertinent to a particular problem with which Applicant was concerned, citing #6 of the list of the items in page 2 of specification, is an improper attempt at hindsight, which additionally fails to establish any equivalence of the problem solved by Schieman or Wilbur and this invention. The problem in Schieman and Wilbur's case is to 'seal an envelope', and the problems this invention solves are of a much wider scope, including among others: 1) to build a form, (so an envelope is obviated) and 2) to seal such self contained form. (See Specification, pages 4 and 5)

Examiner never satisfied his burden of establishing a prima facie case of obviousness, as Examiner proposes an incorporation of dry adhesive with release (page 6, first para. of O.A. of 09/11/2002) which does not serve any practical purpose, and which does not result in the invention, and even if it did, Examiner also fails to explain how or why the references would lead anybody to such conclusion. (See also Appeal Brief, page 24, starting on 3rd para.)

Or how and why a person would determine which parts of Schieman or Wilbur are to be used, and which ones are not (for instance, the glue that keeps the container's panels together), and how the elements from Wilbur or Schieman will be extrapolated to

Johnson and why.

There is no way to logically extrapolate the use of PSA from any of the cited envelopes to a letter sheet, as even if abstracted from the rest of the entire structures, there is no equivalence between the elements involved, regardless of any nomenclature coincidences or discrepancies. See Appeal Brief, page 18, paragraphs 4-7. Please, see Exhibits A-E. See Attachments 15 and 16. See Attachments 21, 22, 23, 24, 25, 26, 27 and 28.

It is further noted that up to this point, Examiner had contended that this invention was an envelope. Therefore the 103(a) rejections were based on that erroneous premise, and the switch in reasoning by the new Examiner proves that the original burden of proving a prima facie case of obviousness had not been satisfied, and as a result, that the rejection is invalid.

None of the arguments presented with the Response of Oct. 17/02 by Applicant were at all addressed by the Examiner. Regarding this issue, among other arguments, Appellant submitted the fact that there is no reason or motivation for such combination. Appellant demonstrated that Johnson actually teaches away from having this invention's features and that other references closer in structure to the sum of the references do not meet the claimed invention, proving a) a long felt need (please, see Affidavit 1, section I beginning on page 2, and its respective source/references); and b) failure by others who have actually produced a closer in structure device, yet have failed to arrive at the invention (please, see Affidavit 1, section II, beginning on page 6 and all the attachments referenced therein; especially ATTACHMENT 9)

(Examiner's Answer, page 8, 2nd para.)

New Examiner now argues that the method of forming the device is not germane to the issue of patentability of the device itself, which is a moot, non-responsive issue, because that is not Appellant's point. Appellant's point is simply that such difficulties teach away from any combination, as there is no reasonable expectation of success to combine

Johnson's string and PSA interacting with a release substance (See appeal Brief, beginning on page 23, 2nd para. through end of page 24)

(Examiner's Answer, page 8, 3rd para.)

After absolute silence during prosecution, New Examiner's response regarding suitability of the invention for laser printers and other heat and friction generating machines is 'non sequitur'. Appellant does not argue that intended use establishes patentability, as suggested by Examiner on last para. of page 8 of Examiner's answer.

The argument by Appellant is that Johnson's tear string impregnated with dry adhesive, which is exposed at all times, will preclude the use of the form with any heat or friction equipment, and the point is that such limitation teaches away from combining Johnson with PSA + Release to obtain the present invention, as the compatibility with laser printers and other heat or friction machines of this invention is one of its purposes.

Furthermore, the allegation is moot as no claim recites any "intended use" as suggested by the Examiner.

In that same paragraph (page 8, last para.), Examiner also submits new arguments related to 'process of making' claims. This is a moot issue, as none of the claims is of that type. All the claims are 'product' or 'article' claims.

After absolute silence during prosecution, regarding the incompatibility of release and pressure sensitive adhesive in Johnson's case, on last para. of page 8, new Examiner unsupportedly alleges that appellant's arguments are opinion, which makes Examiner's statement an opinion, and further an incorrect one, since Appellant exhaustively demonstrated such incompatibility as a fact.

Please, refer to Appeal Brief beginning on 5th para. of page 21 thorough end of page 24. See Amendment C, pages 53-55.

The part where Examiner alleges that "fails to overcome the combination of the prior art as a whole" is not understood. Especially in light of the fact that the necessary burden of

how and why such combination would take place was never satisfied by the Examiner.

In any event, Appellant exhaustively brought to the Examiner's attention in Response of Oct. 17/03 and again in Appeal Brief:

a) why such combination is not desirable, b) why such combination will not result in any useful product (let alone this invention), and c) the fact that after a long felt need, others have produced devices that are structurally closer to this invention, yet have failed to materialize it and to meet its structural and functional features.

Which along other arguments remain undisputed.

Examiner further incorrectly alleges that "there is nothing that precludes 'the incorporation of interactive release and pressure sensitive adhesive'"

Again, please, refer to Appeal Brief beginning on 5th para. of page 22 thorough end of page 24. These arguments were also submitted with paper of Oct. 17/02, and were not addressed by the Examiner. Also, see Amendment C, pages 53-55.

(Examiner's Answer, page 9, 2nd para.)

After an absolute silence during examination regarding the Appellant's dispute of the hypothetical combination of Schieman or Wilbur with Johnson—which remains un-established in terms of 'prima facie' case of obviousness—new Examiner now submits some abstract and stereotyped arguments that fail to address the issues in specific terms related to this case, as Appellant has. Please, see discussion about hypothetical combination of Schieman and Johnson beginning on page 16, last paragraph, through page 18, 3rd paragraph of this Reply Brief. This covers all possible combinations of Johnson with Schieman or Wilbur, because as established in Amendment C, Wilbur's first embodiment is identical to Schieman's second embodiment. And Wilbur's second embodiment, having a flap with coatings on both sides, a fortiori denies any hypothetical combination.

(Examiner's Answer, page 9, 3rd para.)

The Affidavit of "long felt need" was never addressed during examination. New Examiner incorrectly states that "Appellant fails to show that the need has been a persistent one that was recognized by persons having ordinary skill in the art"

Please, refer to "Affidavit 1", beginning on page 2, 10th para. through page 8, 3rd. para. and all the references therein. Note, that the "Self Seal Mailer" by Avery Dennison Corp. was considered novel, as it displays a 'patent pending' indicia. Likewise, product disclosed by Pat 5,087,238 to Olson is commercialized by New England Business Services (NEBS) of Groton, MA. with the commercial name "Laser Taxi". These two companies by far exceed the standard of "ordinary skill in the art."

Also, see discussion of Tissot submitted by original Examiner as a precluding reference, and abruptly abandoned as such. (Amendment A, pages 25-27; and Attachment 6)

(Examiner's Answer, page 9, last para; page 10, 1st para.)

After an absolute silence during Examination, new Examiner selectively addresses one of the arguments submitted by Appellant regarding the triple combination of Johnson with Schieman or Wilbur plus Stenner, and incorrectly refers to Appellants position about Stenner as 'opinion'.

First, Examiner seems to disregard the legal fact that the burden was on Examiner to prove why and how the references can be combined, and how such combination would result in the claimed invention. Burden which was not satisfied other than by a vague stereotyped expression. Stenner's summary provided by Appellant establishes the radical distinctions between the references, and therefore, is a fact, not an opinion. It disproves the notion that anybody would go to that art to look for a solution to an issue related to letter sheets.

The newly alleged by the new Examiner "desirability of Stenner to provide a plurality of

forms in series" (page 10, 1st para. of answer) when combined with the other references, defies logic, as Stenner pieces are massively produced, "stuffed" and sealed at once. Hence, there is no need for a Pressure Sensitive Adhesive, or for a 'temporarily sealing' phase, and without it, there is absolutely no need whatsoever to use any type of release. (Please, see Amendment C, pages 53-55) Examiner also failed to explain how all of this would be done.

In any event, all of this is in essence moot, as Johnson and Stenner's configurations preclude to be built in continuous forms, adopting the PSA + release coatings. Since Examiner does not explain how the references are to be combined, let us consider both scenarios:

- 1) In the case of Johnson, the preclusion is due to the fact that since the form has flaps on its four sides, it is physically impossible to produce them in series because: first, both coatings (PSA and release) must be applied. After this is done, all flaps must be folded against the body to place the continuous forms in final condition, ready to be used. This will simply be impossible, regardless of the orientation of the web, because either flaps 6 and flaps 8, or flaps 7 and 9 will remain in an unfoldable condition along the perforation lines. The forms are not ready, and they can not be used. They do not result in the claimed invention. See specification, FIGS. 14's, 15's, 16, 17's and 18.
- 2) In Stenner's case, due to the necessary unfolded condition of 'composite sheets' or 'webs' 10 a similar situation, precluding the use of PSA in conjunction with release coatings occurs as discussed in Appeal Brief (page 27, 28, and first para. of page 29.).

(Examiner's Answer, page 10, 2nd para.)

After an absolute silence by original Examiner during the prosecution of the case, new Examiner now alleges that since "Johnson was not a secondary or 'teaching'

reference, but instead the primary", the argument by Appellant that it teaches away from the invention is not persuasive.

This new argument by Examiner is of no legal effect, as both references are "teaching" since:

"the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure." MPEP 2142.

There is no discrimination about "primary" and "secondary" in the legal requirements for a prima facie case of obviousness.

Furthermore, since Johnson is never used in a 102(b) rejection (which is normally based on a stand-alone reference) while Schieman in fact is, it appears that Schieman (or Wilbur) are the "primary" reference, regardless of the order in the rejection. And in any event, the combination does not provide any reasonable expectation of success for production or use regardless of any order the references are cited.

(Examiner's Answer, page 10, 3rd para.)

Examiner refers to Paper 33 regarding decisions of the Director about Amendment C and Appellants references thereto, as well as Appellant's petitions. Applicant submitted a summary of such decisions in the form of a chart on page 4 of this Brief.

(Examiner's Answer, page 10, 4th para.)

Examiner states that for the arguments submitted, the rejections should be sustained.

Appellant respectfully replies that all the arguments in the Examiner's answer, are new. Some of which contradict or otherwise disprove previous Examiner's arguments. In any event, none of the arguments in the Examiner's answer supports any of the rejections, and several actually clearly indicate allowability.

Very respectfully,



Luis J. Rodriguez

-----Applicant Pro Se-----

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Date of Mailing: September 08, 2003

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Luis J. Rodriguez, Applicant

Signed: 

In The United States Patent And Trademark Office

Appl. Number: 09/978,215
Appl. Filed: 10/15/01
Applicant: Luis J. Rodriguez
Title: Self Sealing Letter Sheets
Examiner / GAU: Jes F. Pascua / 3727

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BOARD OF PATENT APPEALS
AND INTERFERENCES

SUPPLEMENTAL APPEAL BRIEF

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

This is submitted under 37 CFR 1.193 (b)(1) in response to the "Supplemental Examiner's Answer" with mailing date of July 20, 2004, received by Appellant on July 26, 2004,

About "Status of Amendments"

Once again Examiner incorrectly states that the status of amendments reported by Appellant is incorrect. This incorrectness was in fact one of the reasons that prompted the remand of the case.

About "Issues"

The statement by Examiner regarding the "Issues" is incorrect and confusing. The status of claims reported by Appellant was correct, as Examiner himself indicated on the "Status of Claims". New withdrawal of rejection of claims 45-53 under 112 does not make Appellant's statements incorrect. This withdrawal simply changed the status of claims and Appellant concurs with the new status reported by Examiner.

About “Grouping of Claims”

Examiner retracted his previous statement that all claims fell together, and acknowledges Appellants “Grouping of Claims” in Appeal Brief. This constitutes admission that statement on “Examiner’s Answer” was inappropriate.

Issues

I) Supplemental Examiner’s Answer is in violation of the Boards instructions in Board’s response mailed June 29, 2004.

1. Examiner failed to address all the “New Issues” raised by Appellant on pages 8-11 of Reply brief as requested on page 5, 2nd para. of Board’s response. These are all very serious issues that are once again respectfully brought to the Board’s attention.
2. Examiner’s Supplemental answer failed to address most of arguments on Amendment C, related to Appealed claims; namely:
 - Page 31, discussing proper prior art;
 - Page 38 and 39, discussing the structure of the invention;
 - Pages 40-52 related to 102 and 103 rejections;
 - Pages 53 and 55, related to 102 and 103 rejections;
 - Pages 67-75, related to 102 and 103 rejections;
3. Examiner claims to have considered Attachments 11-31. However, not one single argument therein is addressed at all, much less to the meticulous level required by the Board.
4. Examiner failed to address Exhibits A, B, C, D, and E.
5. Examiner failed to address Exhibit F (Summary of Interview by Appellant)
6. Examiner failed to address Affidavits 2 and 3.

II) Examiner’s Supplemental Answer is simply a reiteration of “Examiner’s Answer” arguments. In most cases is actually copied-and-pasted from it. Examiner’s text fails to

actually identify and discuss the arguments in Amendment C, as clearly instructed by the board (Board's response page 4, third para.) Examiner simply refers to "Appellant's argument in Amendment C (Page such and such) and proceeds to replicate the text from Examiner's Answer.

Examiner further claims that these repeated arguments address Appellants arguments in Appeal Brief, and Reply Brief, which is impossible, as Examiner's arguments were submitted before the Appeal and Reply Brief.

III) It is also important to note that in spite of being confronted with the fact that all rejections are now supported by different reasons, and that all the reasons by original Examiner were completely abandoned, the new Examiner failed to substantively address the issue, and none of the original rejections was actually resubmitted.

Examiner offered some 'a posteriori' explanations that the new reasons are to "buttress" previous reasons, however the previous reasons have completely disappeared.

"Examiner's Answer" flat-out failed to respond to one single argument submitted by Appellant regarding original basis for the rejections. Examiner had again an opportunity to address the arguments by Appellant regarding originals rejections in his Supplemental Answer, but again failed to do so. And furthermore, Examiner additionally failed to address the arguments by Appellant about new Examiner's basis for rejections.

DISPUTE OF "RESPONSE TO ARGUMENTS"

The once again submitted new arguments by the new Examiner are in blatant violation of the Board's specific instructions, the law, and any sense of ethics.

Among many other issues:

- 1) Examiner's assertion that Appellant failed to address the rejection related to the phrase "at least one" in Amendment C, Appeal Brief and Reply Brief is a false statement. As the issue was exhaustively addressed in the three cited documents, it is clear that this is not a mistake. This is a deliberate, or at least very irresponsible false statement.

See last 4 lines of page 2 of Sept. 11/02 O.A. It reads:

«In addition the phrase “at least one” implies that there may be more than one envelope “body”. However, each envelope⁽¹⁾ in the original disclosure has only one “body”. Therefore, the phrase “at least one” as a modifier of “mono-sectional body” is drawn to new matter. This is a new matter rejection»

See Amendment C, page 35, beginning on third para, which addresses the “at least one” issue, by disproving the Examiner’s contention that *«“each envelope⁽¹⁾” in the original disclosure has only one “body”»*. The “at least one” phrase is hence, fully validated, and the rejection should be withdrawn. See also Appeal Brief, page 11, last line, para. 1-5 of page 12. See also page 12 (para. 4-9) of Reply brief.

- 2) Examiner’s assertion that rejection of claim 49 has not been addressed, is also a false statement. See Amendment C, page 35, last three paragraphs. See Appeal Brief, page 12, last 4 paragraphs, continued on page 13. See Reply brief, Reply Brief, page 12, last two paragraphs.
- 3) Examiner further failed to reply to the issue raised in last two paragraphs of Reply Brief, regarding claim 49.
- 4) In an apparent effort to suggest diligence in complying with the Board’s instructions, Examiner reiterates his erroneous allegations regarding the repositionable adhesive issue, and implies that Appellant did not address these issues in Appeal Brief and Reply Brief, which amounts to another false statement. See Appeal Brief, page 13, starting on 3rd para., and continued on page 14. See Reply Brief, page 13, beginning on 2nd para., continued on page 14. See Exhibit F, page 3, para. 6-8.
- 5) At this point, (Examiner’s Supplemental Answer, page 7 (third. para.) through page 10 (two first paragraphs) Examiner embarks in a blatant copy-and-paste campaign of his previous arguments in “Examiner’s Answer” claiming that they are in response to Amendment C, (Examiner inserts some Amendment C page numbers here and there), and that they are also in response to Appeal Brief, and Reply Brief. This is unbelievable. How can these arguments be in response to Appeal Brief and Reply Brief, if they were generated before Appeal Brief, and Reply Brief?. Appeal Brief and Reply Brief, are actually in response to

(1) The disclosed and claimed invention is a Self Sealing letter Sheet, **NOT** an envelope, as characterized by original Examiner.

these arguments.

- 6) Examiner fails to address Affidavits 2 and 3. Regarding Affidavit one, this is another argument copied and pasted from "Examiner's Answer". This is another deliberate or at least very irresponsible false statement, as Affidavit 1 by itself is proof of a persistent need in the art. See Affidavit 1. Furthermore, Amendment C, and Reply Brief offer additional testimony to that effect. See Amendment C, page 66. See Reply Brief, page 21, paragraphs 2 and 3.
- 7) After this, Examiner re-takes the blatant copy-and-paste campaign, related to some 103 rejections, alleging again to be in response to Amendment C, Appeal Brief and Reply brief. (See "Examiners Supplemental Answer, page 10, last para., and three first paragraphs of page 11. Again: How can these arguments be in response to Appeal Brief and Reply Brief, if they were generated before Appeal Brief, and Reply Brief?. Appeal Brief and Reply Brief, are actually in response to these arguments.
- 8) New Examiner then proceeds to some semantic acrobatics, claiming now that his newly submitted reasons are to buttress the Original Examiner's arguments. How is it then, that all the original basis for rejections have completely disappeared from the case? That the invention is an envelope? That it has panels, etc.?

Reply Brief clearly proved that new Examiner has submitted new basis departing from the thrust of the original basis to support the original rejections, which amounts to new rejections.

Confronted with the discrepancies and contradictions between both Examiners, New Examiner now tries to connect his new arguments to one marginal argument of Original Examiner. That is that Appellant's arguments focused on "what the invention is not, rather than in what it is.

Examiner makes transparently clear his negligent Examination, and violation of the Board's instructions. The bulk of Amendment C, was actually prompted by this false contention that Applicant focuses on "what the invention is not, rather than in what it is".

See Amendment C, pages 27-30. See Amendment C, page 39. See Amendment C, pages 41-52. See Amendment C, pages 56-75. See ATTACHMENT 15. See ATTACHMENT 16. See ATTACHMENTS 21-31. See Exhibits A, B, C, D, and E.

Examiner statement that Attachments 11-14 and 15-31 have been considered has no credibility whatsoever, as they are not addressed as per the Board's specific instructions. It is actually evident, that they have not been considered, as Examiner continues to offer arguments disproved by those attachments. Referring to attachments 15-31 will suffice to verify Appellant's statements.

Again, it is notorious the fact that Examiner does not discuss at all Affidavits 2 and 3, and Exhibits A, B, C, D, and E. It is also notorious the eloquent silence regarding Appellant's summary of Interview (Also submitted as Exhibit F), which proves that Original Examiner lied on the record, as original Examiner produced a false Interview Summary; and his contradicting rulings proved his arbitrariness and/or incompetence.

The statement by new Examiner that

«there is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection»

is completely irrelevant to this case because:

1. The basic thrust of the rejection does not remain the same, as all the new basis and reasoning are completely different and independent from the original reasoning. Furthermore, none of the original arguments was at all cited by the new Examiner's Answer.
2. As prosecution has been closed, this is hardly a fair opportunity to react to a new reasoning by a new Examiner who opted to ignore original Examiner's reasoning.
3. Although absolutely unfair and excessively burdening, Appellant did react to the new rejections, and Examiner still opted to ignore Appellants arguments to the new rejections, as evidenced by a lack of a reply, or even acknowledgment of the arguments to the new rejections.

It is clear that Examiner's Supplemental Answer is in violation of the law and the Board's instructions to meticulously address all the arguments and issues presented by Appellant. Such unresponsiveness is a clear concession that all the rejections are invalid. Accordingly, Appellant respectfully requests that all the rejections are reversed.

Respectfully submitted,


Luis J. Rodriguez

-----Pro-Se Applicant-----

Date: July 28, 2004

CERTIFICATE OF MAILING:

Date of Mailing: July 28/04

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Luis J. Rodriguez,

Pro-Se Applicant

Signed: 

In The United States Patent And Trademark Office

Appl. Number: 09/978,215
Appl. Filed: 10/15/01
Applicant: Luis J. Rodriguez
Title: Self Sealing Forms
Examiner / GAU: Stephen P. Garbe / 3727

Summary of Interview

Type of Interview: Telephonic
Date of Interview: October 29, 2002
Participants: Luis Rodriguez (Applicant)
Stephen Garbe (Examiner)

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Assistant Commissioner for Patents
Washington, DC 20231

Sir:

Applicant very respectfully submits a summary of the interview referenced above, as follows:

- 1) Regarding the Advisory Action dated 10/25/02, and particularly the Examiner's allegation that the "elimination of 'at least one', in claim 45 raises a new issue", which was used as the basis to refuse entry of Amendment C, applicant pointed out that Office Action of September 11/02 rejected the same claim 45 under 35 USC 112 for adding "at least", and that therefore refusal to enter Amendment C obviously lacks any proper basis, because "elimination of 'at least one' could only overcome the previous rejection.[*]

Applicant respectfully complained about the contradicting actions of the Office, and indicated that they have had a clearly unfair effect in the prosecution of this case, and particularly referred

[*] So there is no confusion on the record:

Applicant elected to remove "at least" from claim 45, instead of disputing the rejection. The September 11/02 rejection was also improper as there were more than adequate antecedents for the expression "at least" (one body) in the original specification, which disclosed more than one body in the 13th and 14th embodiment examples (Figs. 24's and 25's, and corresponding text), and as extensively discussed in **Amendment C**.

to this instance, since Amendment C, which contains valuable factual information to explain and advance this case for allowance, was refused entry for one of these improper reasons.

Applicant stated that this case felt like a 'catch 22' situation.

- 2)** Regarding the Office Action of September 11/02, Applicant inquired about Examiner's allegation that the phrase "relates to a blank" constituted new matter in the substitute specification of Aug. 23/02, and his refusal to enter it, pointing out that 'a blank' was **not** new matter, as it was literally recited by original claim 17, and that therefore refusal to enter the substitute specification was improper.

Applicant also indicated that **ATTACHMENT 17** ("*Cross Reference of Substitute Specification to Original Specification*") discusses each individual amendment made by addition, referencing each entry to the specific location where it was discussed in the original specification, and/or offering a legal explanation where pertinent or necessary.

Examiner indicated that if the clarification regarding 'letter size' (on page 1 of Substitute Specification) was not in the original specification, that it would constitute new matter.

Applicant replied that while new *language* was certainly used, no new matter was introduced (Applicant again referred the Examiner to **ATTACHMENT 17**).

And that the reason for this is that the original title "***Self Sealing Forms***" does not inherently convey the size restricting effects as the term "**Letter**" does, because the term "**Letter**", is commonly used to designate **8½" by 11"** pieces of paper. And that without the clarification, the amended disclosure may be interpreted to apply **exclusively** to forms (or letter sheets) of **8 ½" x 11"** size, limitation that **was not** in the original disclosure.

And that all this clarification does is to prevent the original disclosure to be unduly restricted to an 8 ½" x 11" letter size by the Substitute Specification.

Applicant officially and formally re-stated that there is no new matter in the specification as sworn in the "*Statement of No New Matter*" filed with the "*Request for Continued Examination*".

- 3) Only** claims 50 and 68 were discussed. (*The allusion to claim 45 in # 1) above related to the non-entry of the Amendment. Patentability of claim 45 was not discussed.*)

- 4) Regarding claim 50**, applicant referred Examiner to page 39 of Amendment C, which illustrates claim 50 and all its elements as they relate to a drawing of the invention, in its most basic form.

Upon checking the referenced page, Examiner replied: "I won't allow claims of that scope"

Applicant inquired: "*Why not? That is a picture claim.*"

Examiner replied: "*I don't know what you mean by a picture claim*"

Applicant explained —*what (pro-se) applicant has gathered from different readings*— that a 'picture' claim essentially recites each and every element of the invention.

- 5) Regarding Claim 68**, after reading the pertinent locations in original specification, as pointed out by applicant, Examiner admitted that the repositionable adhesive (204) had been disclosed in original specification (which established the invalidity of the rejection, and hence, the allowability of the claim).

However, Examiner stated that applicant should have indicated where the disclosure of repositionable adhesive was.

Applicant indicated that **Amendment C** pointed out to the many different specific locations in original specification where repositionable adhesive (**204**) was discussed.

- 6)** Examiner mentioned that the application disclosed many different embodiments.

Applicant replied that there are no extension limits for a patent application.

Applicant also indicated that applicant has been diligent in addressing all the issues raised by the Office via arguments and/or amendments and that to assist the Office in examining this case, applicant has supplied numerous illustrated materials and visual aids, which graphically summarize the arguments and that judging by the Office Actions, they all appear to have been ignored by the Office.

Applicant respectfully complained about the depth of this case's examination, in view of the incoherence of Office's Actions with respect to applicant's and Office's own previous communications and stated: "It seems as if this case is not being examined at all"

- 7) Applicant requested that model of invention [submitted under 37 CFR 1.91(a)(3)] be compared with models of Schieman and Wilbur [submitted under 37 CFR 1.91(a)(1)]
- 8) In response to applicant's complaints, Examiner indicated that any disagreements should be presented to the Board of Appeals and Interferences, for arbitration.

Applicant replied that he intends to take that course of action, but that the refusal to enter the **Amendment C** and the **Substitute Specification** submitted with the Request for Continued Examination, can only be resolved by The Commissioner, upon Petition, and requested that Examiner reconsidered his decisions regarding these matters, so such procedure can be avoided.

Examiner inquired why applicant wanted the Substitute Specification entered.

Applicant replied that since it was apparent from Office's Actions that the Examiner has misunderstood the invention, as disclosed in the original specification, the specification needed to be amended to better teach the invention, to the Office and to the public.

Applicant further indicated that as per the MPEP, even if something in the substitute specification is perceived as 'new matter', such new matter needs to a) be properly identified, b) objected to and c) required to be canceled.

Applicant asserted his right to have the substitute specification submitted with RCE (amendment B) entered, especially in light of the fact that it contains no new matter and again referred the Examiner to **ATTACHMENT 17**, which is a cross reference of amendments to their initial discussion in the original specification.

-----END OF SUMMARY OF INTERVIEW-----

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CERTIFICATE OF MAILING:**Date of Mailing:** November 22, 2002

I hereby certify that this correspondence, including its attachments is being deposited with the United States Postal Service "EXPRESS MAIL TO ADDRESSEE" service **ET444555035US** under 37 CFR 1.10 on the date indicated above, and is addressed to Box AF, Commissioner for Patents, Washington, D.C. 20231

Luis J. Rodriguez, Applicant

Signed: _____

